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ELECTION

Applicant elects, with traverse, what the Examiner has characterized as "Invention T", deemed drawn to a phantom for MR, and corresponding to claims 1-7.

REMARKS

The Examiner has alleged four 'inventions' in the pending claims. The Examiner has based restrictions on each set of independent claims. The Examiner's classification of the 'inventions' include Group I consisting of claims 1-7 drawn to a phantom for MR and classified by the Examiner in class 324, subclass 308, Group II consisting of claims 8-15 drawn to a method of manufacturing a phantom and classified by the Examiner in class 436, subclass 8, Group III consisting of claims 16-22, drawn to a method of evaluating MR applications and classified by the Examiner in class 324, subclass 309, and Group IV consisting of claims 23-25 drawn to a kit to form human brain phantom and classified by the Examiner in class 424, subclass 9.3.

Claim 16 has been amended to correct an inaccuracy. No new matter has been added.

Inventions I and II

The Examiner related Inventions I and II as product made and process of making under MPEP §806.05(f). Office Action, p. 2. A product made and a process for making the product can be shown to be distinct inventions if "(A) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products; or (B) that the product as claimed can be made by another and materially different process." MPEP §806.05(f). The Examiner has not shown that the product as claimed can be made by another and materially different process. The Examiner stated that "the phantom of group I does not requires (sic) composition of a first combination of paramagnetic powder, agarose powder, deuterium oxide, and water in a first set of interstitial cavities; and a second combination of paramagnetic powder, agarose powder, deuterium oxide, and water in a second set of interstitial cavities as required in group II." Office Action, p. 2. This, however, does not show that the product can be made by another and materially different process. The statement is also not true since the dependent claims of group I do indeed require these elements in one form or another. See claims 2-6.

Specifically, the process calls for, in part, the step of depositing the first combination and the second combination such that the paramagnetic powder and the agarose powder mix with the

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water to form a paramagnetic gel and an agarose gel in each tube, respectively. The product made calls for, in part, a first section containing material to emulate the MR properties of white matter of a human brain and a second section containing material to emulate the MR properties of gray matter of a human brain. The Examiner has not presented another and materially different process by which the product is made such that Inventions I and II are shown to be distinct.

The Examiner has also not shown that the process is not an obvious process of making the product or that the process can be used to make other and different products. The Examiner stated that "the phantom manufactured in group II does not requires (sic) being for emulating the MR properties of white and gray matter of the human brain as required in group I." Office Action, pp. 2-3. However, claim 8 clearly states that it is a method of manufacturing a phantom for MR evaluation.

Therefore, the Examiner has failed to present other and different products that can be made by this process and has failed to compare the dependent claims of each group.

The Examiner further stated that "the search required for Group II is not required for Group I...." Office Action, p. 5. However, if the dependent claims and the groups are reviewed as a whole, the Examiner must perform the same search for both inventions. The Examiner classified Invention I in class 324, subclass 308 directed to using a nuclear resonance spectrometer system including a test sample and control sample. See class 324, subclass 308 definition. The Examiner classified Invention II in class 436, subclass 8 directed to "compositions for standardization, calibration, simulation, stabilization, preparation or preservation: processes of use in preparation for chemical testing." See class 436, subclass 8 definition. A search in the subclass for the MR phantom of Invention I would necessarily include a search in the subclass of the method of manufacturing a phantom of Invention II, and vice-versa. Each invention has a (1) phantom structure for (2) MR evaluation that has (3) material to emulate (4) different proton densities. How can a search for Invention I be separate from a search for Invention II?

As such, the Examiner has failed to show (1) that Inventions I and II are distinct and (2) that a field of search for Invention I is separate from a field of search for Invention II. Therefore, for at least these reasons, a restriction under MPEP §806.05(f) between Inventions I and II is improper, and Applicant requests rejoinder of Inventions I and II.

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Inventions I and III

The Examiner related Inventions I and III as product and process of use under MPEP §806.05(h). Office Action, p. 3. Inventions I and III "can be shown to be distinct inventions if either or both of the following can be shown: (A) the process of using as claimed can be practiced with another materially different product; or (B) the product as claimed can be used in a materially different process." MPEP §806.05(h) (emphasis added). The Examiner has the burden to provide an example. Id.

The Examiner stated that "the MR method of using the phantom in group III does not requires (sic) providing a phantom with a first section containing material to emulate the MR properties of white matter of a human brain, and a second section containing material to emulate the MR properties of gray matter of a human brain as required in group I." Office Action, p. 3. The Examiner does not suggest either an example of another materially different product that can be practiced by the process of using or an example of the product used in a materially different process. The burden has not shifted to the Applicant to prove or provide a convincing argument "that the alternative use suggested by the examiner cannot be accomplished..." (MPEP §806.05(h)) because the Examiner has provided no such suggested use. Accordingly, for this reason alone, the restriction must be withdrawn.

Notwithstanding the above remarks, the field of search for Inventions I and the field of search for Invention III are not separate. The Examiner classified Invention I in class 324, subclass 308 directed to using a nuclear resonance spectrometer system including a test sample and control sample. See class 324, subclass 308 definition. The Examiner classified Invention III in class 324, subclass 309 directed to using a nuclear resonance spectrometer system to obtain localized resonance within a sample. See class 324, subclass 309 definition. If Applicant elects Group I, does the Examiner intend to not look in subclass 309? A search in the subclass for the MR phantom of Invention I would necessarily include a search in the subclass of the method of evaluating MR applications of Invention III, and vice-versa, which dictates rejoinder.

Also, claim 1 calls for, in part, a first section containing material to emulate the MR properties of white matter of a human brain and a second section containing material to emulate the MR properties of gray matter of a human brain. Claim 21 of Invention III calls for, in part, wherein the first tissue corresponds to white matter in a human brain and the second tissue corresponds to gray matter in a human brain. Thus, each has a (1) phantom for (2) MR applications that has (3) material to emulate (4) different proton densities. How can a search for Invention I be separate from a search for Invention III?

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As such, the Examiner has failed to show that (1) Inventions I and III are distinct and (2) that a field of search for Invention I is separate from a field of search for Invention III. Therefore, for at least these reasons, a restriction under MPEP §806.05(h) between Inventions I and III is improper, and Applicant requests rejoinder of Inventions I and III.

Inventions I and IV

The Examiner related Inventions IV and I as combination and subcombination under MPEP §806.05(c). Office Action, p. 3. MPEP §806.05(c) states that Inventions I and IV are distinct "if it can be shown that a combination as claimed: (A) does not require the particulars of the subcombination as claimed for patentability..., and (B) the subcombination can be shown to have utility either by itself or in other and different relations."

The Examiner stated that "the combination as claimed does not require the particulars of the subcombination as claimed because the phantom of group I does not requires (sic) composition of a first and second combination of paramagnetic material, agarose material, deuterium oxide, and water as required in group IV." Office Action, p. 3. However, that is the very essence of a combination/subcombination -- one has something the other does not. That alone does not rise to a valid restriction.

As required by MPEP §806.05(c), "[t]he burden is on the examiner to suggest an example of separate utility." The Examiner has not even suggested a showing of separate utility by the subcombination; therefore, the burden has not shifted to the Applicant and remains on the Examiner. Rejoinder is required.

Furthermore, the Examiner stated that "[b]ecause these inventions are distinct for the reasons given above and the search required for Group IV is not required for Group I, restriction for examination purposes as indicated is proper." Office Action, p. 5. However, a field of search for Invention I is not separate from a field of search for Invention IV. The Examiner classified Invention I in class 324, subclass 308 directed to using a nuclear resonance spectrometer system including a test sample and control sample. See class 324, subclass 308 definition. The Examiner classified Invention IV in class 424, subclass 9.3 directed to magnetic imaging agent of in vivo diagnosis or in vivo testing. See class 424, subclass 9.3 definition. Where in this claim group does it state, or even imply, in vivo use? A search in the subclass for the MR phantom of Invention I would necessarily include a search in the subclass of the kit to form human brain phantom of Invention IV, and vice-versa. Each invention has a (1) phantom structure for (2) MR

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applications that has (3) material to emulate (4) different proton densities. How can a search for Invention I be separate from a search for Invention IV?

As such, the Examiner has failed to show (1) that Inventions I and IV are distinct and (2) that a field of search for Invention I is separate from a field of search for Invention IV. Therefore, for at least these reasons, a restriction under MPEP §806.05(c) between Inventions I and IV is wholly improper, and rejoinder of Inventions I and IV is required under the MPEP guidelines and the CFR rules.

Inventions II and III

The Examiner related Inventions II and III as "process of making and process of using the product." Office Action, p. 3. The Examiner stated that "[t]he inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product used (2) that the product in the method of using a product as claimed can be made by another and materially different process (MPEP §806.05(f))." Office Action, pp. 3-4. The Examiner has misapplied MPEP §806.05(f) to inventions related as process of making and process of using the product. MPEP §806.05(f) is directed to inventions related as process of making and product made, not process of making and process of using the product as the Examiner has related Inventions II and III.

Furthermore, the Examiner has misstated the test for distinctness as set forth in MPEP §806.05(I). MPEP §806.05(I) does not set forth the test as stated by the Examiner that the inventions can be shown to be distinct if "(1) the process as claimed can be used to make other and materially different product used (2) that the product in the method of using a product as claimed can be made by another and materially different process...." Office Action, pp. 3-4 (emphasis added). Rather, MPEP §806.05(I) states that the inventions can be shown to be distinct if "(A) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products; or (B) that the product as claimed can be made by another and materially different process." Simply, MPEP §806.05(f) does not apply to Invention II, a process of using a product.

Therefore, since the Examiner has failed to properly set forth or apply any rules of distinction between Inventions II and III related as process of making and process of using the product, the restriction must be withdrawn.

Notwithstanding the above remarks, the field of search for Inventions II and the field of search for Invention III are not separate. The Examiner stated that "the phantom used in the MR

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method of group III does not requires (sic) a composition of a first combination of paramagnetic powder, agarose powder, deuterium oxide, and water in a first set of interstitial cavities; and a second combination of paramagnetic powder, agarose powder, deuterium oxide, and water in a second set of interstitial cavities as required in group II." Office Action, p. 4. Claim 21 of Invention III calls for, in part, wherein the first tissue corresponds to white matter in a human brain and the second tissue corresponds to gray matter in a human brain. The Examiner classified invention II in class 436, subclass 8 directed to "compositions for standardization, calibration, simulation, stabilization, preparation or preservation: processes of use in preparation for chemical testing." See class 436, subclass 8 definition. The Examiner classified invention III in class 324, subclass 309 directed to using a nuclear resonance spectrometer system to obtain localized resonance within a sample. See class 324, subclass 309 definition. Applicant has no idea how the Examiner extracted "chemical testing" for that claimed in Group II. Each of these "inventions" has a (1) phantom for (2) MR applications that has (3) material to emulate (4) different proton densities. How can a search for Invention II be separate from a search for Invention III?

Therefore, a search in the subclass for the method of manufacturing a phantom of Invention II seems that it would necessarily include a search in the subclass of the method of evaluating MR applications of Invention III, and vice-versa, and a field of search for Invention II is not separate from a field of search for Invention III.

As such, the Examiner has failed (1) to properly apply any rules of distinction for Inventions II and III related as process of making and process of using the product and (2) to show that a field of search for Invention II is separate from a field of search for Invention III. Therefore, for at least these reasons, a restriction under MPEP §806.05(I) between Inventions II and III is wholly improper, and rejoinder is required.

Inventions II and IV

The Examiner related Inventions II and IV as process of making and product made under MPEP §806.05(I). Office Action, p. 4. A product made and a process for making the product can be shown to be distinct inventions if "(A) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products; or (B) that the product as claimed can be made by another and materially different process." MPEP §806.05(I). The Examiner has not shown that the product can be made (1) by another and (2) materially different process. The Examiner has also not shown either that the

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process is not an obvious process of making the product or that the process can be used to make other and different products.

The Examiner stated that "the phantom of group IV does not require water in the composition as required in group II." Office Action, p. 4. This does not show that the product can be made by another and materially different process. Specifically, claim 23 of the product made calls for, in part, first and second mixtures comprising paramagnetic material, agarose material, and deuterium oxide wherein the first mixture has a proton density substantially equivalent to human brain white matter and the second mixture has a proton density substantially equivalent to human brain gray matter. Paragraph [0030] of the specification states that "[i]t is envisioned that the dry elements of the mixture can be placed in one of the respective tubes 80 and then the liquid component(s) added thereto. In this manner, the agarose, being a dry element, when mixed with hot water, dissolves and, when cooled, solidifies the mixture in the form of a gel." The "agarose material" called for in claim 23 includes an agarose gel formed by mixing the dry element agarose and hot water as described in the specification

The Examiner also stated that "the method of manufacturing a phantom of group II does not require providing a first mixture with a proton density substantially equivalent to human brain white matter, and second mixture has a proton density substantially equivalent to human brain gray matter as required in group IV." Office Action, p. 4. The Examiner has not shown either that the process is not an obvious process of making the product or that the process can be used to make other and different products. The Examiner has not shown how depositing first and second combinations of paramagnetic powder, agarose powder, deuterium oxide, and water in sets of interstitial cavities as called for, in part, in claim 8 of Invention II is not an obvious process of making first and second mixtures comprising paramagnetic material, agarose material, and deuterium oxide wherein the first mixture has a proton density substantially equivalent to human brain white matter, and the second mixture has a proton density substantially equivalent to human brain gray matter as called for, in part, in claim 23 of Invention IV. Also, the Examiner has not suggested any "other and different products" that can be made by the process. Therefore, distinction has not been shown, and restriction is improper.

Furthermore, the Examiner stated that "[b]ecause these inventions are distinct for the reasons given above and the search required for Group IV is not required for Group II, restriction for examination purposes as indicated is proper." Office Action, p. 5. The Examiner classified invention II in class 436, subclass 8 directed to "compositions for standardization, calibration, simulation, stabilization, preparation or preservation: processes of use in preparation for chemical

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testing." See class 436, subclass 8 definition. The Examiner classified Invention IV in class 424, subclass 9.3 directed to magnetic imaging agent of in vivo diagnosis or in vivo testing. See class 424, subclass 9.3 definition. However, the claims of each group are for neither chemical testing nor in vivo diagnosis testing. Each invention has a (1) phantom for (2) MR applications that has (3) material to emulate (4) different proton densities. How can a search for Invention II be separate from a search for Invention IV?

Because the Examiner has not shown either (1) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products or (2) that the product as claimed can be made by another and materially different process, a search in the subclass for the method of manufacturing a phantom of Invention II would necessarily include a search in the subclass of the kit to form human brain phantom of Invention IV, and vice-versa.

As such, the Examiner has failed to show (1) that Inventions II and IV are distinct and (2) that a field of search for Invention II is separate from a field of search for Invention IV. Therefore, for at least these reasons, a restriction under MPEP §806.05(f) between Inventions II and IV is improper, and rejoinder of Inventions II and IV is required.

Inventions III and IV

The Examiner related Inventions IV and III as product and process of use under MPEP §806.05(h). Office Action, p. 3. Inventions III and IV "can be shown to be distinct inventions if either or both of the following can be shown: (A) the process of using as claimed can be practiced with another materially different product; or (B) the product as claimed can be used in a materially different process." MPEP §806.05(h). The Examiner has the burden to provide an example. Id.

The Examiner stated that "the phantom used in method of group III does not require a composition of a first and second combination of paramagnetic material, agarose material and deuterium oxide; and providing a first mixture with a proton density substantially equivalent to human brain white matter, and second mixture has a proton density substantially equivalent to human brain gray matter as required in group IV." Office Action, pp. 4-5. The Examiner does not suggest either an example of another materially different product that can be practiced by the process of using or an example of the product used in a materially different process. The burden has not shifted to the Applicant to prove or provide a convincing argument "that the alternative

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use suggested by the examiner cannot be accomplished...." (MPEP §806.05(h)) because the Examiner has provided no such suggested use.

Furthermore, Invention III calls for, in part, wherein the material includes deuterium oxide (claim 19), wherein the phantom further includes paramagnetic gel, agarose gel, and water (claim 20), and wherein the first tissue corresponds to white matter in a human brain and the second tissue corresponds to gray matter in a human brain (claim 21). The Examiner's statement that "the phantom used in method of group III does not require a composition of a first and second combination of paramagnetic material, agarose material and deuterium oxide; and providing a first mixture with a proton density substantially equivalent to human brain white matter, and second mixture has a proton density substantially equivalent to human brain gray matter as required in group IV" simply does not show either (1) that the process of using as claimed can be practiced with another materially different product or (2) that the product as claimed can be used in a materially different process when Invention III includes that which the Examiner stated is not required. Therefore, distinction has not been shown, and restriction is improper.

Notwithstanding the above remarks, the field of search for Inventions III and the field of search for Invention IV are not separate. The Examiner classified Invention III in class 324, subclass 309 directed to using a nuclear resonance spectrometer system to obtain localized resonance within a sample. See class 324, subclass 309 definition. The Examiner classified Invention IV in class 424, subclass 9.3 directed to magnetic imaging agent of in vivo diagnosis or in vivo testing. See class 424, subclass 9.3 definition. The claims do not state or suggest in vivo diagnosis or testing. Each invention has a (1) phantom for (2) MR applications that has (3) material to emulate (4) different proton densities. How can a search for Invention III be separate from a search for Invention IV?

Because the Examiner has not shown either (1) that the process of using as claimed can be practiced with another materially different product or (2) that the product as claimed can be used in a materially different process, a search in the subclass of the method of evaluating MR applications of Invention III would necessarily include a search in the subclass of the kit to form human brain phantom of Invention IV, and vice-versa.

As such, the Examiner has failed to show (1) that Inventions III and IV are distinct and (2) that a field of search for Invention III is separate from a field of search for Invention IV. Therefore, for at least these reasons, a restriction under MPEP §806.05(h) between Inventions III and IV is improper, and Applicant requests rejoinder of Inventions III and IV.

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Summary

Under the Examiner's theories of restriction, each independent claim must be worded identically to avoid restriction. There is no support for such in the U.S. Code, the CFR, or even in the MPEP. Further, identical claims would be fruitless and result in double patenting. While restriction practice has its place, it should not be used haphazardly. The restrictions applied in this case are so far from complying with the MPEP, they appear haphazard and punitive to Applicant. Applicant is entitled to multiple independent claims, as long as each is directed to the same invention and has been properly paid for -- and that is the case in this application.

For all these reasons, Applicant respectfully requests rejoinder of all claims, of each group. The Examiner is invited to call the undersigned to discuss this Election or any other matters regarding this application to further prosecution.

Respectfully submitted,



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